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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,047	10/11/2001	Benny B. Johansen	RXSD 1020-1	1000
22470	7590	07/01/2005	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP			TRAN, CON P	
P O BOX 366			ART UNIT	
HALF MOON BAY, CA 94019			PAPER NUMBER	
			2644	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,047

Applicant(s)

JOHANSEN ET AL.

Examiner

Con P. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/26/01, 4/28/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Applicant is advised that should claim 1 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 5-13, 15-24** are rejected under 35 U.S.C. 102(e) as being anticipated by Horn U.S. Patent 6,379,314 (cited by Applicants).

Regarding **claims 1 and 12**, Horn teaches a method of testing the hearing of a user utilizing a computer system, the computer system including a computer and a speaker, the computer operable to output an electrical signal to the speaker, the speaker operable to convert the electrical signal into a stimulus (see Abstract; col. 3, lines 14-25), the method comprising:

- a) downloading a computer program from a server to the computer (internet);
- b) executing the computer program on the computer, the execution of the computer generating an audio stream (i.e., electronic data, Abstract);
- c) based upon the audio stream, generating a stimulus (e.g., sound); and
- d) receiving an input from the user that indicates if the user heard the stimulus (see Abstract; col. 3, lines 14-25).

Regarding **claim 2**, Horn further teaches wherein the computer program includes an audio parameter and wherein the audio stream is generated based upon the audio parameter (table of value; col. 4, lines 37-45).

Regarding **claims 3 and 13**, Horn further teaches wherein the act of downloading the computer program includes transferring the computer program from the server to the computer via the Internet (see Abstract; col. 3, lines 14-25).

Regarding **claims 5 and 15**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one frequency of the stimulus (250-12,00Hz; Abstract; col. 3, lines 14-25; col. 4, lines 37-45).

Regarding **claims 6 and 16**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one amplitude of the stimulus (different amplitudes, i.e. dB; Abstract; col. 3, lines 14-25).

Regarding **claims 7 and 17**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one type of the stimulus (white noise, col. 5, lines 8-10; pure tone; col. 5, lines 21-27).

Regarding **claim 8**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates that two stimulus types should be combined to generate the stimulus (pure tone; col. 5, lines 21-27).

Regarding **claim 9**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates that the

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program should determine which stimulus should be presented in the test (table of value; col. 7, line 58 – col. 8, line 9).

Regarding **claim 10**, Horn further teaches wherein the act of generating a stimulus includes generating a stimulus within a user-defined frequency range (base line; col. 4, lines 34-45).

Regarding **claims 11 and 18**, Horn further teaches the method of claim 1, further including a) sending first data to the server; b) qualifying the hearing of the user; and c) sending second data to the computer (see Abstract; col. 3, lines 14-25)..

Regarding **claims 19-24**, these claims merely specifies a program necessary for operating (performing) to method claim of claims 1-2, and 6-11 and is therefore interpreted and rejected for the same reasons. It should be noted that claim 19 including limitations of claim 11.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn U.S. Patent 6,379,314 (cited by Applicants) in view of Admitted Prior Art (hereinafter, "APA").

Regarding **claims 4 and 14**, Horn teaches the method of claim 1. Horn disclose transferring a computer program over Internet (col. 3, lines 14-19). However, Horn does not explicitly disclose, wherein the act of downloading the computer program includes transferring the computer program from the server to the computer via an email.

APA discloses as is well known, computer programs may be attached to emails that can be easily distributed over the Internet.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the program as disclosed by Horn via email as taught by Admission in order to easily distribute the program.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 1, and 3-4** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over **claims 1-3** of copending Application No. 09/975581 in view of Horn. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The copending application claims a hearing test computer program downloaded through the Internet and executed on a computer to set an tone control. The copending application does not claim control of the audio stream. However, Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet audio stream (i.e., electronic data, Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and computer program of the copending application with the audio stream of Horn to set a tone control for establishing user's values.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran whose telephone number is (571) 272-7532. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Vivian C. Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; and 571-273-8300 effective July 15, 2005.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cpt CPJ
June 27, 2005


XU MEI
PRIMARY EXAMINER